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| 09/713,512 | 11/14/2000 | Nicolaas M.J. Vermeulin | 275102001001 | 4513 |

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EXAMINER

O SULLIVAN, PETER G

| ART UNIT | PAPER NUMBER |
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1621

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12

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

Application Number: 09/713,512

Filing Date: 14 November 2003

Appellant(s): Vermeulin et al.

Burton A. Amernick

For Appellant

Art Unit: 1621

EXAMINER'S ANSWER

This is in response to the appeal brief filed 27 May 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant states that, for each rejection, the involved claims stand or fall together.

(8) Claims Appealed

Claim 77 is omitted in the Appendix to the brief. Accordingly, claim 77 is correctly written in the Appendix to the Examiner's Answer.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

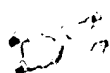
WO 91/00853 Cherksey et al. 24 January 1991

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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Claims 36-61, 63-77 and 88-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherksey et al. who disclose lysylspermine on page 19 to be useful as a P channel activator. Cherksey et al. differ from the instant invention in that appellant claims a stereoisomer thereof as well as position isomers/homologues. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of Cherksey et al., to make appellant's compounds and to expect them to be useful as P channel activators. It is expected there will be differences in activity of various stereoisomers in biological systems. In re Adamson, 125 U.S.P.Q. 233. In re May, 197 U.S.P.Q. 601. Position isomers/homologues are also held to be obvious. In re Mills, 126 U.S.P.Q. 513.

Claims 36-61, 63-77 and 88-95 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/396,523. Although the conflicting claims are not identical, they are not patentable distinct because they generically overlap. Appellant has indicated willingness to file a terminal disclaimer.

(11) *Response to Argument*

Cherksey et al. state, "Illustrative of polyamines useful as such channel regulating agents are the following compounds:" of which lysyl spermine is one (p. 19). Appellants provide a showing of beneficial results obtained by using a specific stereoisomeric form, but it is expected there will be differences in activity of various stereoisomers in biological systems.

For the above reasons, it is believed that the rejections should be sustained.



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Respectfully submitted,

Peter G. O'Sullivan

Primary Examiner

A.U. 1621

3 November 2003

Conferees

Johann R. Richter

Supervisory Patent Examiner

A.U. 1621

Samuel A. Barts

Primary Examiner

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APPENDIX

77. The method of claim 76 wherein said administration by injection is intravenous, subcutaneous, intramuscular, intracranial, or intraperitoneal.